

AMENDMENTS TO THE DRAWINGS

The attached sheets include changes to Figures 4 and 5 to include sequence identification numbers. In particular, Figure 4B has been amended to refer to SEQ ID NO: 3. Figure 5B has been amended to refer to SEQ ID NO: 8.

Attachment: Replacement Sheets

*REMARKS/ARGUMENTS**The Pending Claims*

Claims 1, 4-9, and 12-18 are pending and are directed to a sulfite composition (claims 1 and 4-6), a method for deaminating DNA using the sulfite composition (claims 7-9 and 12), a method for detecting methylated DNA using the sulfite composition (claims 13-16), and a kit comprising a sulfite composition (claims 17 and 18). Claims 7-9 and 12-16 are listed as withdrawn, since the claims are directed to non-elected subject matter in response to a restriction requirement.

Amendments to the Specification

Table 3 of the specification has been amended to include sequence identification numbers. No new matter has been added by way of this amendment to the specification.

Amendments to the Claims

Claim 1 has been amended to incorporate the features of claims 2 and 3 (now canceled). Similarly, claims 7 and 13 have been amended to incorporate the features of claims 10 and 11 (now canceled). The amendments to claims 1, 7, and 13 are also supported by the specification at, for example, page 9, lines 6-9, page 11, lines 13-21, and page 14, lines 3-7. Accordingly, no new matter has been added by way of these amendments to the claims.

Amendments to the Drawings

Figures 4B and 5B have been amended to include sequence identification numbers (SEQ ID NOs: 3 and 8, respectively). No new matter has been added by way of these amendments to the drawings.

The Examiner is requested to approve the accompanying replacement drawings.

Summary of the Office Action

The Examiner objects to the specification as allegedly containing sequences that are not identified by sequence identification numbers.

The Examiner objects to the drawings because Figures 4 and 5 allegedly contain sequences which are not identified with sequence identification numbers.

The Examiner rejects the claims as allegedly anticipated as set forth below:

(a) claims 1-3, 6, 17, and 18 under 35 U.S.C. § 102(a) in view of EP 1443052 (“the ‘052 application”),

(b) claims 1, 2, and 6 under 35 U.S.C. § 102(b) in view of U.S. Patent 3,966,880 (“the ‘880 patent”),

(c) claims 1-3, 6, 17, and 18 under 35 U.S.C. § 102(e) in view of U.S. Patent Application Publication 2006/0058518 (“the ‘518 publication”), and

(d) claims 1, 2, and 4-6 under 35 U.S.C. § 102(b) in view of U.S. Patent 3,971,734 (“the ‘734 patent”).

Reconsideration of these objections and rejections is hereby requested.

Discussion of the Objections to the Specification and Drawings

The Office objects to Table 3 of the specification and Figures 4B and 5B for allegedly containing sequences that are not identified by sequence identification numbers. Applicants have amended Table 3 of the specification to include sequence identification numbers. Additionally, Applicants have amended Figures 4B and 5B to contain sequence identification numbers.

Applicants believe the objections are moot in view of the amendments to the specification and drawings. Accordingly, Applicants request that the objections be withdrawn.

Discussion of the Anticipation Rejections

The Office contends that claims 1-6, 17 and 18 are anticipated by one of more of the ‘052 application, the ‘880 patent, the ‘518 publication, and the ‘734 patent.

Claims 1-6, 17 and 18, as amended, recite that the sulfite composition has a sulfite concentration of 8 M to 10 M and a pH of 5.0 to 5.6. None of the cited references discloses a sulfite composition or kit comprising a sulfite composition with the claimed features. Since none of the cited references teaches each and every element of the pending claims, the cited references cannot be considered to anticipate the pending claims.

Furthermore, Applicants note the '052 application published on April 8, 2004, and is considered to be prior art under 35 U.S.C. § 102(a). Applicants herein submit a certified English translation of JP 2004-114476 (filed on April 8, 2004). The priority document supports the subject matter of the pending claims as evidenced by the claims of the certified English translation (see pages 1-2). Accordingly, the subject matter of the pending claims was invented prior to the publication of the '052 application such that the '052 application does not qualify as prior art under Section 102(a).

For the above-described reasons, pending claims 1-6, 17 and 18 cannot be considered to be anticipated by any of the cited references, and the anticipation rejections should be withdrawn.

Rejoinder of Claims Directed to the Process of Using the Claimed Product

As set forth in the Office Action dated April 14, 2008 (see pages 2-3) and in accordance with MPEP § 806.05(f), when the Office requires restriction between product and process claims and Applicants elect claims directed to the product, which claims are subsequently found to be allowable, withdrawn process claims that depend from or otherwise include all the limitations of the allowable product claims will be rejoined in accordance with the provisions of MPEP § 821.04. In the event of rejoinder, the requirement for restriction between the product claims and the rejoined process claims will be withdrawn, and the rejoined process claims will be fully examined for patentability in accordance with 37 CFR § 1.104.


Non-elected claims 7-9 and 12-16 are directed to a method of using the sulfite composition as defined in claim 1. Thus, claims 7-9 and 12-16 include the features of claim 1.

Applicants therefore request, upon a finding that claim 1 is in condition for allowance, that the restriction requirement as to the process claims (i.e., the claims of Group II) be withdrawn and that the aforementioned method claims be rejoined and examined.

Conclusion

Applicants respectfully submit that the patent application is in condition for allowance. If, in the opinion of the Examiner, a telephone conference would expedite the prosecution of the subject application, the Examiner is invited to call the undersigned attorney.

Respectfully submitted,



John Kilyk, Jr., Reg. No. 30,763
LEYDIG, VOIT & MAYER, LTD.

Two Prudential Plaza, Suite 4900
180 North Stetson Avenue
Chicago, Illinois 60601-6731
(312) 616-5600 (telephone)
(312) 616-5700 (facsimile)

Date: September 16, 2008